

REMARKS/ARGUMENTS

In the Office Action mailed June 28, 2005, claims 1-22 were rejected. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references.

STATUS OF THE CLAIMS

Claims 1-22 remain pending in the application and are believed to be patentable over the cited prior art. Claims 1, 9, 16 and 21 are amended to further clarify the claimed invention and obviate the rejections. No claims are added. No claims are cancelled.

CLAIM REJECTIONS – 35 U.S.C. §103(a)

I. Claims 1, 2, 8, 10-11, 12, 16, and 21-22

Claims 1, 2, 8, 10-11, 12, 16, and 21-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 5,451,929 to Adelman *et al.* ("Adelman") in view of United States Patent No. 6,543,282 to Thompson ("Thompson"). Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. MPEP §2142; *In re Oetiker*, 977 F.2d 1443, 1449 (Fed. Cir. 1992). To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to modify the references or to combine reference teachings. MPEP §2143.01, citing *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Second, there must be reasonable expectation of success. MPEP §2143.02, citing *In re Merck & Co., Inc.*, 800 F.2d

1091, 1097 (Fed. Cir. 1986). Finally, the prior art must teach all the claim limitations. MPEP §2143.02, *citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974).

Applicants respectfully point to the first prong of the test, which states there must be some suggestion or motivation to modify the references or to combine reference teachings. §2143.01, *citing In re Rouffet*, 149 F.3d at 1357 (Fed. Cir. 1998). The law is clear that there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the modification suggested by the Examiner. *Id.* “[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). Thus, it follows that *prima facie* obviousness is undermined by a disclosure that teaches away from or discourages – instead of suggests or motivates – the claimed invention. *In re Sponnoble*, 405 F.2d 578, 587 (C.C.P.A. 1969).

On page 3 of the Office Action, it is stated that it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicants to modify the device taught by *Adelman* with the airflow monitor taught by *Thompson* because the modification would result in a device that could provide a more efficient airflow monitor using a thermistor element. To the contrary, Applicants assert that *Thompson* teaches away from the present invention.

A reference teaches away “when a person of ordinary skill, upon reading the reference ... would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). After reading *Thompson*, one skilled in the art would be led in a direction divergent from “a second element exposed to an ambient environment . . . the second element is configured to determine an ambient condition,” as recited in claims 1, 16, and 21 of the present invention because *Thompson* teaches a second thermistor that is “heated to

a target temperature greater than a highest specified operating ambient temperature and maintains the temperature of the second thermistor regardless of the actual ambient temperature.” *Thompson* at col. 3, lines 50-54. As indicated by the aforementioned disclosure, *Thompson* discourages a second thermistor for determining an ambient condition. Instead, *Thompson* teaches a second thermistor heated above an ambient condition. As such, *Thompson* teaches away from “a second element exposed to an ambient environment . . . the second element is configured to determine an ambient condition,” as recited in claims 1, 16, and 21.

In view of the foregoing, withdrawal of the 35 U.S.C. §103(a) rejection to independent claims 1, 16, and 21 as being unpatentable over *Adelman* in view of *Thompson* is respectfully requested. Further, claims 2, 8, 10-11, 12, and 22 depend from one of claims 1, 16, and 21 and, therefore, include all of the features recited in one of claims 1, 16, and 21. It is therefore respectfully submitted that these claims are patentable over *Adelman* in view of *Thompson* for at least the same reasons as discussed in response to the rejection of claims 1, 16, and 21 as being unpatentable over *Adelman* in view of *Thompson*. In light of the foregoing, withdrawal of the 35 U.S.C. §103(a) rejection to claims 2, 8, 10-11, 12, and 22 as being unpatentable over *Adelman* in view of *Thompson* is respectfully requested.

II. Claims 4-7, 13, and 17-19

Claims 4-7, 13, and 17-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Adelman* in view of *Thompson* as applied to claims 1 and 16. Applicants respectfully traverse this rejection because claims 4-7, 13, and 17-19 depend from one of independent claims 1 and 16 and, therefore, include all of the features recited in one of claims 1 and 16. It is therefore respectfully submitted that these claims are patentable over *Adelman* in view of

Thompson as applied to claims 1 and 16 for at least the same reasons as discussed in response to the rejection of claims 1 and 16 as being unpatentable over *Adelman* in view of *Thompson*. In light of the foregoing, withdrawal of the 35 U.S.C. §103(a) rejection to claims 4-7, 13, and 17-19 as being unpatentable over *Adelman* in view of *Thompson* as applied to claims 1 and 16 is respectfully requested.

III. Claims 3, 14-15, and 20

Claims 3, 14-15, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Adelman* in view of *Thompson* as applied to the claims above, and further in view of United States Patent No. 6,107,925 to Wong (“*Wong*”). Applicants respectfully traverse this rejection because claims 3, 14-15, and 20 depend from one of independent claims 1 and 16 and, therefore, include all of the features recited in one of claims 1 and 16. It is therefore respectfully submitted that these claims are patentable over *Adelman* in view of *Thompson* as applied to the claims above, and further in view of *Wong* for at least the same reasons as discussed in response to the rejection of claims 1 and 16 as being unpatentable over *Adelman* in view of *Thompson*. In light of the foregoing, withdrawal of the 35 U.S.C. §103(a) rejection to claims 3, 14-15, and 20 as being unpatentable over *Adelman* in view of *Thompson* as applied to the claims above, and further in view of *Wong* is respectfully requested.

IV. Claim 9

Claim 9 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Adelman* in view of *Thompson* as applied to the claims above, and further in view of United States Patent No. 5,217,513 to Armbruster (“*Armbruster*”). Applicants respectfully traverse this rejection

because claim 9 depends from independent claim 1 and, therefore, include all of the features recited in claim 1. It is therefore respectfully submitted that claim 9 is patentable over *Adelman* in view of *Thompson* as applied to the claims above, and further in view of *Armbruster* for at least the same reasons as discussed in response to the rejection of claim 1 as being unpatentable over *Adelman* in view of *Thompson*. In light of the foregoing, withdrawal of the 35 U.S.C. §103(a) rejection to claim 9 as being unpatentable over *Adelman* in view of *Thompson* as applied to the claims above, and further in view of *Armbruster* is respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the objections and rejections to the claims be removed. If, for any reason, the Examiner disagrees, please call the undersigned patent agent at 202-861-1561 in an effort to resolve any matter still outstanding before issuing another action. The undersigned patent agent is confident that any issue which might remain can readily be worked out by telephone.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 87319.4340.

Respectfully submitted,
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